

**REMARKS**

- Claims 1-43 were pending in the present application, before the amendments requested herein.
- Claims 44 – 52 have been **added** herein. Each of the newly added claims is supported by the specification as filed, such that no new matter has been added.
- Claims 29 – 33 have been **cancelled** herein. Applicants expressly reserve the right to pursue the subject matter of claims 29 – 33 in a continuing application.
- Claims 1, 34, and 40 have been **amended** herein. Each of these claims is an independent method claim.
- Upon entry of these amendments, which are respectfully requested for the reasons set forth below, claims 1 – 28, and 34 – 52 will be pending. Of the claims that will be pending, only claims 1, 34 40, and 44 – 52 are independent.

**I. Telephone Interview**

Applicants thank Examiner for extending the courtesy of a telephone interview on December 03, 2002. The amendments requested herein are believed to be in conformance with the amendments discussed during this interview.

**II. §101 Rejection**Claims 1 – 5, 12 – 15, 21 – 28, and 34 - 39

Claims 1 – 5, 12 – 15, 21 – 27 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Claims 1 – 5, 12 – 15, 21 – 28 and 34 – 40 stand rejected under 35 U.S.C. §101 as allegedly not resulting in a useful and tangible result. (¶1, pg. 2 of paper no. 5).

Claim 1, before the amendments made herein, recited the limitation of “offering a consumer the second rebate”. Applicants do not agree that this is not a useful and tangible result. However, to expedite prosecution of the present application, Applicants have amended claim 1 herein to recite a step of “issuing the second rebate to the customer.” Applicants thus respectfully submit that the §101 rejection of claim 1 has been overcome. Claims 2 – 5, 12 – 15, and 21 – 28 are each dependent on claim 1 and thus include each of the limitations of claim 1. Accordingly, Applicants respectfully submit that the §101 rejection of these claims has also been overcome with the aforementioned amendment to claim 1.

Claim 40

Claim 40, an independent method claim, recites a step of “issuing the second rebate to the consumer”, even before the amendments made herein. Issuing a rebate is a useful and tangible result (as is even admitted by Examiner on page 2 of paper number 5). Accordingly, Applicants submit that Examiner’s §101 rejection of claim 40 is improper and request that it be withdrawn.

Claims 29 – 33

Claims 29 – 33 stand rejected under 35 U.S.C. §101 as allegedly merely setting forth a disembodied data structure. Without agreeing or disagreeing with Examiner’s assertion, Applicants have cancelled claims 29 – 33 herein. Accordingly, the rejection of claims 29 – 33 is moot.

**III. §112 Rejection**

Claims 1 – 28 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The step of “obtaining the documentation...” as added to claim 1, applicants believe, overcomes Examiner’s concerns regarding claim 1. However, the addition of this step is not an agreement by Applicants that claim 1 was indefinite as it was pending before the amendment made herein.

Regarding claim 28, Examiner asserted that this claim is incomplete for omitting the essential step of a redemption. Applicants respectfully traverse this rejection. Redemption of the second rebate (or the first rebate) is not an essential step of the present invention. As discussed during the telephone interview, a second rebate may be issued to a customer without it necessarily being redeemed by the customer, without rendering the claim incomplete. Accordingly, Applicants respectfully request that Examiner withdraw the §112 rejection of claim 28.

**III. §102 Rejection**

Claims 1 – 6, 16, 17, and 34 stand rejected under 35 U.S.C. §102 as being anticipated by the January 5, 1999 Buffalo News article “Rebate Limits Can Be A Pain for Consumers” (hereinafter “Buffalo News”).

Claims 1 and 34

Claims 1 and 34, each an independent claim, have each been amended herein to recite the limitations that the first rebate is “*redeemable by mailing a predetermined document associated with the first rebate to a first entity associated with the first product*” and the step of “*obtaining the predetermined document, surrendered by the consumer at a retailer terminal operated by a second entity, such that the consumer can no longer redeem the first rebate*”. These limitations make it clear that, in accordance with the one or more embodiments encompassed by claims 1 and 34, a consumer can only redeem one of the first rebate and the second rebate. Buffalo News, in contrast, simply teaches that a plurality of rebates may be provided to a consumer.

There is not teaching or suggestion in Buffalo News, or any other prior art of record, that the consumer can only redeem one of the rebates or that the consumer surrenders documentation necessary for redemption of the first rebate at a retailer terminal when the second rebate is issued or redeemed. Accordingly, Applicants respectfully submit that claims 1 and 34 are now in condition for allowance.

Claims 2 – 6, 16, and 17

Claims 2 – 6, 16, and 17 are each dependent on claim 1, include each of the limitations of claim 1, and are thus patentable at least for the same reasons as claim 1. Accordingly, Applicants respectfully submit that claims 2 – 6, 16, and 17 are now in condition for allowance as well.

**IV. §103 Rejection**

Claims 7 – 10, 29 – 33, 35, and 38 – 43

Claims 7 – 10, 29 – 33, 35, and 38 – 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Buffalo News in view of U.S. Patent No. 5,200,889 to Mori (hereinafter “Mori”).

Claims 7 – 10 are dependent on claim 1, which has been amended as discussed above. The features added by the amendments made herein to claim 1 are not taught by Buffalo News or by Mori, alone or in combination. Accordingly, Applicants respectfully submit that the §103(a) rejection of claims 7 – 10 over Buffalo News in view of Mori has been overcome.

Claims 29 – 33 have been cancelled herein. Accordingly, this rejection thereof is now moot.

Claims 35, 38 and 39 are each dependent on claim 34, which has been amended to include the limitations recited above with reference to the §102(b) rejection of claim 34. The limitations added to claim 34 are not taught or suggested by Buffalo News or Mori, alone or in combination. Accordingly, Applicants respectfully submit that the §103(a) rejection of claims 35, 38, and 39 has been overcome.

Claim 40, an independent claim, has been amended herein to include the same limitations as claims 1 and 34, discussed above with respect to the §102(b) rejection. Neither Buffalo News nor Mori teaches or suggests the limitations added to claim 40. Accordingly, Applicants respectfully submit that the §103(a) rejection of claim 40 has now been overcome.

Claims 41 – 43 are each dependent on claim 40, thus including each of the limitations of claim 40, and are thus patentable at least for the same reasons as claim 40.

Claims 14, 15, and 22 – 27

Claims 14, 15, and 22 – 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Buffalo News in view of the July 8, 1994 article in the Los Angeles Times entitled “Loyalty: Check it Out” (hereinafter “LA Times”).

Claims 14, 15, and 22 – 27 are each dependent on claim 1, which has been amended in the manner discussed with respect to the §102(b) rejection. Neither Buffalo News nor LA Times, alone or in combination, teaches or suggests the limitations added

to claim 1. Accordingly, Applicants respectfully suggest that claims 14, 15, and 22 – 27 are now patentable at least for the same reasons as claim 1.

#### Claim 11

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Buffalo News and Mori in view of LA Times.

Claim 11 is dependent on claim 1, which has been amended in the manner discussed with respect to the §102(b) rejection. Neither Buffalo News nor Mori nor LA Times, alone or in combination, teaches or suggests the limitations added to claim 1. Accordingly, Applicants respectfully suggest that claim 11 is now patentable at least for the same reasons as claim 1.

#### Claims 12, 13, 36 and 37

Claims 12, 13, 36, and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Buffalo News in view of U.S. Patent No. 5,901,303 to Chew (hereinafter “Chew”).

Claims 12 and 13 are each dependent on claim 1 and claims 36 and 37 are each dependent on claim 34. Claims 1 and 34 have each been amended in the manner discussed with respect to the §102(b) rejection. Neither Buffalo News nor Chew, alone or in combination, teaches or suggests the limitations added to claims 1 and 34. Accordingly, Applicants respectfully suggest that claims 12, 13, 36 and 37 are now patentable at least for the same reasons as claims 1 and 34, respectively.

#### Claim 20

Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Buffalo News. Claim 20 is dependent on claim 1, which has been amended in the manner discussed with respect to the §102(b) rejection. Accordingly, claim 20 now includes the limitations added to claim 1. Buffalo News does not teach or suggest such limitations. Accordingly, Applicants respectfully submit that the §103(a) rejection of claim 20 has been overcome.

#### Claim 28

Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Buffalo News in view of U.S. Patent No. 5,845,259 to West et al. (hereinafter “West”). Claim 28 is dependent on claim 1, which has been amended in the manner discussed with respect to the §102(b) rejection. Accordingly, claim 28 now includes the limitations added to claim 1. Neither Buffalo News nor West, alone or in combination, teaches or suggests the limitations added to claim 1, which are now included in claim 20. Accordingly, Applicants respectfully submit that the §103(a) rejection of claim 20 has been overcome.

### **V. Allowable Subject Matter**

Applicants gratefully acknowledge Examiner’s statement that claim 18 includes allowable subject matter. (¶12, pg. 8 of paper no. 5).

## VI. Newly Added Claims

### Claims 44 - 46

Claim 44, an independent method claim, has been added, as discussed during the telephone interview, to encompass one or more embodiments wherein a consumer is prevented from redeeming a first rebate if the consumer has obtained a second rebate for the same product. This prevention is done based on a determination of whether an address that the consumer provided in requesting the redemption of the first rebate is the same as an address that the consumer provided when obtaining the second rebate. Such a method of preventing a consumer from redeeming a first rebate if the consumer has already obtained a second rebate for a product is not taught or suggested by any of the prior art of record.

Claim 45 is an independent apparatus claim corresponding to claim 44 and claim 46 is an independent article of manufacture claim corresponding to claim 44. Accordingly, claims 45 and 46, because they each include each of the limitations of claim 44, are patentable for the same reasons as discussed with respect to claim 44.

### Claims 47 and 48

Claim 47 is an independent apparatus claim corresponding to independent method claim 1. Claim 48 is an independent article of manufacture claim corresponding to independent method claim 1. Accordingly, claims 47 and 48, because they each include each of the limitations of claim 1, are patentable for the same reasons as discussed with respect to claim 1.

### Claims 49 and 50

Claim 49 is an independent apparatus claim corresponding to independent method claim 34. Claim 50 is an independent article of manufacture claim corresponding to independent method claim 34. Accordingly, claims 49 and 50, because they each include each of the limitations of claim 34, are patentable for the same reasons as discussed with respect to claim 1.

### Claims 51 and 52

Claim 51 is an independent apparatus claim corresponding to independent method claim 40. Claim 52 is an independent article of manufacture claim corresponding to independent method claim 40. Accordingly, claims 51 and 52, because they each include each of the limitations of claim 40, are patentable for the same reasons as discussed with respect to claim 1.

**VII. Conclusion and Petition for Extension of Time**

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

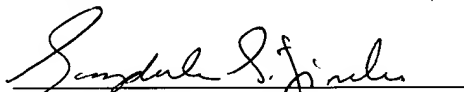
Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7041 or via electronic mail at mfincham@walkerdigital.com.

**Petition for Extension of Time to Respond**

Applicants do not believe any petition or fee for an extension of time with which to respond to the Office Action is due. However, if such a fee should be due, please charge it to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



Magdalena M. Fincham  
Agent for Applicants  
Registration No. 46,085  
mfincham@walkerdigital.com  
Stamford, CT 06905  
203-461-7041 / voice  
203-461-7300 / fax

December 4, 2002

Date

## CLAIM AMENDMENTS VERSION WITH CHANGES MARKED

Please **AMEND** claims **1, 34, and 40** as follows:

1. (AMENDED) A method, comprising:
  - identifying a product associated with a first rebate, the first rebate being redeemable by mailing a predetermined document associated with the first rebate to a first entity associated with the first product;
  - determining a second rebate associated with the product; [and]
  - offering to a consumer the second rebate in exchange for the first rebate;
  - obtaining the predetermined document, surrendered by the consumer at a retailer terminal operated by a second entity, such that the consumer can no longer redeem the first rebate; and
  - issuing the second rebate to the consumer.
34. (AMENDED) A method of processing rebates, comprising:
  - identifying a first rebate associated with a product, the first rebate being redeemable by mailing a predetermined document associated with the first rebate to a first entity associated with the first product;
  - determining an alternative rebate associated with the product;
  - accepting input indicative of a selection of the alternative rebate; and if selected,
  - obtaining the predetermined document, surrendered by a consumer at a retailer terminal operated by a second entity, such that the consumer can no longer redeem the first rebate; and
  - issuing the alternative rebate to the consumer.
40. (AMENDED) A method, comprising:
  - identifying a product;
  - identifying a first rebate and a second rebate associated with the product, the first rebate being redeemable by mailing a predetermined document associated with the first rebate to a first entity associated with the first product;

receiving an acceptance of the second rebate from a consumer;  
obtaining the predetermined document, surrendered by a consumer at a retailer terminal operated by a second entity, such that the consumer can no longer redeem the first rebate;  
issuing the second rebate to the consumer; and  
receiving a request from the consumer to redeem the second rebate.